

REMARKS

The Official Action of February 18, 2003 has been carefully considered; accordingly, the amendments presented herewith for the claims of the application, taken with the following remarks, are believed sufficient to place the application in condition for allowance.

On page 2 of the action, claims 1-7 were rejected under 35 USC 112, second paragraph as indefinite for the reasons pointed out with respect to claims 1, 2 and 4. As applied to the amended claims, this rejection is respectfully traversed and reconsideration is requested.

By this amendment, claim 1 is amended to meet the Examiner's objections with respect to antecedent basis and to make some other minor changes in the claim. Claim 2 is also amended to overcome the antecedent basis problem with respect to the "aqueous extract" and claim 4 is amended to overcome the indefinite objection with respect to "chopped leaves". Claim 4 is not amended with respect to the phrase "about" with respect to the ratio of leaves to water. The term "about" is typically used in United States patents in this manner and is clearly not indefinite. Therefore, reconsideration of this aspect of the objection is requested.

In addition, step c) of claim 1 has been amended to delete the reference to physical force and simply state that the water-leaf mixture from step b) is subjected to maceration.

Claims 1-7, all the claims, stand rejected as obvious over Steinkraus (Indigenous Fermented Foods), in view of Applicants' admissions on pages 1-6 of the specification. As applied to amended claims 1-7, this rejection is respectfully traversed and reconsideration is requested.

Steinkraus teaches the production of pulque. It is a national drink of Mexico and is produced by fermenting the juice of *Agave*, mainly *A. astrovirens* or *A. americana*." (page 389). On page 392, it is stated that fermentation can be conducted with pure yeast cultures to produce a final product in 2 to 3 days. On page 394, the sugar content of the leaves is discussed. Reference is made to recent improvement in the production of pulque whereby, "the whole agave plant, including stems and leaves" are mechanically pressed. (Page 397). Also, "the concentrated *Agave* syrup [is] being distributed to manufacturers in order to shorten the fermentation and improve the quality of the product." However, Steinkraus does not teach that one of the *Agave* plants can be blue agave, that nutrients are added to the fermentation or that leaves are macerated.

The Examiner bases his rejection on three reasons. The Examiner found that "[i]t would have been obvious to those of ordinary skill in the art to use the blue agave leaves as a source of sugar to produce alcoholic beverages because, as stated by applicants, the agave plant is becoming scarce and further, those in the beverage art are always trying to produce new and different products to fulfill consumer demand. The Examiner further found that "the well known method of mashing, involving the addition of water, to a solid starch material, such as agave, is notoriously well known and therefore, it would have been obvious to those of ordinary skill in the art to that which is commonly practiced in the art". The Examiner then concludes, "Lastly it would have been obvious to those of ordinary skill in the art to use the claimed fermentation additives, as they are notoriously well known and used in the fermentation art for the reasons set forth above, e.g. they accelerate the fermentation.

Applicants respectfully traverse the Primary Examiner's findings that the Applicants' claimed methods are obvious over Steinkraus in view of the Applicants admission because the prior

arts cited by the Examiner do not teach, suggest, or motivate one in the ordinary skill to combine or modify the arts within the meaning of 35 USC 103 to result in the claimed invention.

In rejecting the Applicants' claims for obviousness, the Examiner combines and modifies the references of Steinkraus and Applicants' admission in the absence of any reason, suggestion, or motivation from the references themselves to do so. Therefore, the Examiner's conclusions are contrary to the patent laws. According to the United States Court of Appeals for the Federal Circuit, "obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention," unless there is some teaching, suggestion or motive supporting the combination. *In re Geiger*, 2 U.S.P.Q. 1276, 1278 (Fed. Cir. 1987). If the reason to combine or modify the prior art is not apparent from the references themselves, the Examiner must provide an explanation for the combination or modification. *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I. 1987). Furthermore, the question of obviousness is a factual question which "could not be resolved on subjective belief and unknown authority." *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2001).

Applicants submit that the Examiner's rejection is inappropriate because it is based on a combination of prior art and modification of that prior art by the Examiner to find Applicants' claims obvious. Applicants contend that the bases for rejection is combination and modification of the prior arts because the claimed methods are not disclosed in either reference. In addition, an inference of why the combination or modification fails under 35 USC 103 is clear from the Examiner's admission that "Steinkraus does not specifically teach one of the Agave plants can be blue agave; that nutrients are added to the fermentation or that the leaves are macerated." The failure of the rejection is emphasized from the fact that the arts described in either reference are distinguishable from each other and do not suggest that one of ordinary skill would want to combine or modify them for any purpose. Since the rejection is based on combination and modification of

the arts that do not motivate one in the ordinary skill to combine or modify them, the Examiner's rejection is improper. *See In re Geiger*, 2 U.S.P.Q. at 1278.

Applicants respectfully traverse the Primary Examiner's findings that the Applicants' claimed methods are obvious over Steinkraus in view of the Applicants admission because the Examiner's rejection is based solely on his own conclusory statement rather than concrete evidence.

In rejecting the claimed methods, the Examiner did not provide any documentary evidence to support his finding other than the conclusory statement that the claimed methods are obvious or notoriously well known. The United States Court of Appeals for the Federal Circuit have held that such a rejection is clearly improper. The Court held that "[w]ith respect to core factual findings in a determination of patentability, ..., the [Examiner] cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the [Examiner] must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). "Thus when [the Examiner] rely on what [it] assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record... The [Examiner] cannot rely on conclusory statements when dealing with particular combination of prior art and specific claims, but must set forth the rationale on which it relies." *In re Lee*, 61 U.S.P.Q.2d at 1435. Therefore, absent any concrete explanation or evidence for its conclusion, the Examiner's rejection is improper.

To support his position, the Examiner refers to *In re Levin*, 84 U.S.P.Q. 232, 234 (C.C.P.A. 1949), wherein the Court of Customs and Patent Appeal stated that a claim of adding or eliminating common ingredients is not patentable unless the applicant establishes a coercion or cooperative relationship between the selected ingredient which produces a new, unexpected, and useful function. It is the Applicants' contention that the combination of method steps of using the leaves, macerating

the leaves, and fermenting the resulting sugars produces a new, unexpected, and useful result. It is also the Applicants' contention that the claimed methods are novel and patentable method claims. The Court of Appeals for the Federal Circuit has held that an Examiner cannot reject claims that contain a novel and patentable combination, even if the elements in the combination are old. *See Acromed Corp. v. Sofamor Danek Group, Inc.*, 59 U.S.P.Q.2d 1130, 1137 (Fed. Cir. 2001).

The Examiner should note that the claims in this application are directed to a process for production of alcohol from the leaves of the blue agave plant using the steps set forth in the claims. While the contents of the references cited by the Examiner have been noted, there is no suggestion in any of the references, taken alone or in combination, to use the steps required by Applicants' process claim to produce alcohol from the leaves of the blue agave plant. A comparison of the disclosures of the Steinkraus reference with the disclosures of Applicants' admission, shows that there is no teaching or suggestion in those references, considered alone or in combination, which will result in the process claimed in this application. As the Board of Patent Appeals and Interferences pointed out in *Ex parte Obukowicz*, 27 USPQ 2d 1063 (1993), a prior art reference that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it, may make a certain approach obvious to try but does not make the invention obvious.

The Board of Patent Appeals and Interferences also pointed out in *Ex parte Deutschman et al.*, 114 USPQ 556, that there is no legal basis for denying an applicant a combination claim where only some of the steps are old in the art and others are novel.

That is precisely the situation here. There is knowledge in the art that alcohol can be obtained from the blue agave plant. However, there is nothing in the references relied on by the Examiner which teaches or suggests that the steps of Applicants' process as claimed can be used to

produce alcohol from the leaves of the blue agave plant. Therefore, Applicants' claims are directed to novel and unobvious subject matter and the rejections based on this prior art should be withdrawn.

It is believed that the above represents a complete response to the Official Action and serves to place the application in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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